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REMARKS

Claims 1-14 are pending in this application.

REMARKS / DISCUSSION OF ISSUES

Claims 1-14 are pending in the application.

The Office action rejects claims 1-2, 4-5, and 11-14 under 35 U.S.C. 102(b) over Ananda (USP 5,638,513). The applicant respectfully traverses this rejection.

The Examiner's attention is again requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Ananda teaches a security system that assures that a user is connected to a web-site of a provider of software whenever the user is using the software.

Claim 1, upon which claims 2-5 depend, claims a method for limiting simultaneous copies of content material, comprising communicating a copy of the content material to a receiving device, communicating a security challenge to the receiving device when the copy of the content material is communicated to the receiving device, and receiving a security response, based on the security challenge, from the receiving device when the copy of the content material is removed from the receiving device.

Ananda does not teach receiving a security response when a copy of the software is removed from the receiving device. Ananda is silent with regard to removing the software from the receiving device.

The Office action cites Ananda, column 9, line 66 through column 10, line 10 for this teaching. The cited text follows:

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"One function of the header software 320 is to prevent unauthorized use of the application software 310. The rental security manager 321 performs this function. The rental security manager 321 interfaces with the application software 310 through the interface parameters 315. The rental security manager 321 determines whether the user may continue to access the application software 310 using a series of tests. When the user passes the periodic test, the user is authorized to continue executing the application software 310. When the test fails, the rental security manager 321 terminates execution of the application software 310 and notifies the user of unauthorized rise." (Ananda, column 9, line 66 through column 10, line 10.)

The applicant respectfully notes that the cited text is silent with regard to removing software from the user's system, and thus cannot be said to teach receiving a security response from the receiving device when the copy of the content material is removed from the receiving device, as specifically claimed in claim 1.

In response to the applicant's prior remarks, the Examiner proposes a variety of additional teachings to Ananda, such as a supposition that "it is essential that the content material is removed or erased" by Ananda, in order for Ananda to terminate execution of the application software, and/or the supposition that Ananda does not store the program on the host computer and only stores the program in a circular buffer. The applicant respectfully notes, however, that the imposition of such additional teachings by the Examiner do not conform to the requirements of MPEP 2131 that the *identical invention* must be shown in as *complete detail* as is contained in the claim.

Further, the applicant respectfully notes that there are many ways of preventing the execution of a program without requiring the removal of the program from a host computer. The Examiner's assertion would imply that the presence of a program on a computer necessarily means that the program will execute on the computer. Password-requiring programs belie this assertion, as do programs that limit the number of times a user can use a program, for evaluation, before paying a fee for the program. As is well known in the art, there are a variety of techniques available to prevent the execution of a program that do not require the removal of the program from the host computer.

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In like manner, the Examiner's assumption that the temporary storage of a program in a circular buffer that is used by a processor necessarily implies that the program is not stored elsewhere in a host computer system is unfounded. The applicants respectfully note that a conventional processor's circular buffer is typically much smaller than most conventional programs. The program code is generally stored in persistent memory, and portions of the program are transferred in blocks from the persistent memory to the circular buffer as the code in each block is required for execution. The deletion of the code from the circular buffer does not cause the removal of the program from persistent memory.

Further, even assuming in argument that the Examiner's additional teachings can be applied, the applicant notes that the proposed combination of the Examiner's teachings with Ananda does not correspond to the applicant's claimed invention, because the proposed combination does not teach receiving a security response based on a security challenge from a receiving device when the copy of the content material is removed from the receiving device. Instead, the proposed combination teaches removing the copy of the content material when the security response based on the security request is not received. This difference between the applicant's claimed invention and the proposed combination is contrary to the requirements of MPEP 2131 that the *identical invention* must be shown in as *complete detail* as is contained in the claim.

Claim 11, upon which claims 12-14 depend, claims a receiving device that receives content material and a corresponding security challenge from a check-out/check-in device, comprising a memory that is configured to store the content material and the corresponding security challenge, and a security device that is configured to erase the content material from the memory, and communicate a security response to the check-out/check-in device, based on the security challenge that is associated with the content material.

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As noted above, Ananda does not address removing content material from a receiving device, and thus cannot be said to teach a security device that is configured to erase the content material from a memory, as specifically claimed in claim 11.

Also, as noted above, assuming in argument that the Examiner's additional teachings are combined with Ananda, the proposed combination does not teach a security device that erases the content material from the memory and communicates a security response to a check-out/check-in device, as claimed by the applicant. Instead, the proposed combination teaches that the device that *receives* a security response, and then terminates operation of a program.

The Examiner asserts that Ananda's notice to the user corresponds to the applicant's claimed security response. However, the applicant's claimed security response is specifically claimed to be sent to the check-out/check-in device from which the security challenge is received. Ananda does not teach that the user's device that receives the notice of termination of the program is the same device from which the security challenge is received.

Assuming in argument that the combination of the Examiner's teaching and Ananda teaches that the device to which the user's notification of termination is sent is also the device that provides the security challenge upon which the termination is based, the applicant respectfully maintains that such a device would not be operative to perform the intended security function of Ananda's system. Ananda's system is specifically designed to provide a security challenge to the user's computer, and to terminate the operation of a program when the sender of the security challenge is no longer coupled to the user's computer. If the user's computer and the sender of the security challenge are the same device, as proposed by the Examiner's assertions, then the coupling is permanent, and termination will never occur.

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Because Ananda does not teach each element of each of the applicant's independent claims 1 and 11, the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 1-2, 4-5, and 11-14 under 35 U.S.C. 102(b) over Ananda.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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